REMARKS

Claims 2-8, 11-14, and 17-20 remain pending in this application. Claims 3 and 4 are withdrawn. Claims 2 and 5-20 are rejected. Claim 1 is previously cancelled. Claims 9-10 and 15-16 are cancelled herein. Claims 5 and 6 are amended for minor formalistic reasons.

Claims 9, 10, 12, 15, 16, and 18-20 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 9, 10, 15, and 16 have been cancelled, making their rejection moot.

The disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue. *See Cordis Corp. v. Medtronic AVE Inc.*, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003). Thus, even if the present specification provided implicit support for claims 12 and 18-20, this would be sufficient to fulfill the requirements of 35 U.S.C. § 112, first paragraph. The present specification, however, goes beyond implicit support since explicit support is provided. On the first full paragraph of page 3 of the specification it is stated that "the outer periphery of the microlens array is restricted for the purpose of satisfying the requirements that the lenses disposed in the central area and the lenses in the peripheral area should have the same optical performance." This provides explicit support for positioning a restrictor for homogenizing the optical performance of glass elements in the center and the periphery of the lens preform.

Accordingly, it is Applicant's position that claims 12 and 18-20 are fully supported by the specification. The subject matter of claims 12 and 18-20 is a main characteristic of the present invention. Additional disclosure regarding such subject matter can also be found in, for example, the specification on page 3, second full paragraph, and page 5, first and second full paragraphs, and the paragraph bridging pages 9-10.

In light of the above, Applicant respectfully requests that the written description requirement rejection of claims 12 and 18-20 be withdrawn.

Claims 2, 5-7, 12, 13, and 18-20 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,305,194 (Budinski et al.) in view of JP 60-171234 (Shimizu et al.). An English translation of Shimizu et al. is attached for the Examiner's convenience.

The Office Action states that it would be obvious to combine Budinski et al. and Shimizu et al. by using the sliding core parts of Shimizu et al. in the invention of Budinski et al. to prevent the inclination of the molding die surfaces as taught by Shimizu et al. The Supreme Court has made clear that a claim composed of several elements "is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art" and stated the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *See KSR International Co. v. Teleflex Inc. et al.* 82 USPQ2d

1385, 1396 (2007). Budinski et al. does not disclose any problems with the molding die surface being at an incline and, therefore, there is no reason to combine Budinski et al. with Shimizu et al. Moreover, the Office Action, on page 4, lines 18-21, cites Budinski et al. for the proposition that the resulting lenses are free from surface figure distortion. As stated in the attached Declaration Under 37 C.F.R. § 1.132 ("Declaration") in the section of Inclination of Lens Surfaces, such language in Budinski et al. would be interpreted by one of ordinarys skill in the art to mean that there is no inclination problem with the lens surfaces in the invention of Budinski et al. Accordingly, one of ordinary skill in the art would not combine Budinski et al. with Shimizu et al. to avoid the inclination of the molding surfaces.

Also, claims 5 and 6 recite a platform for positioning the intermediate restrictor and the intermediate restrictor being put on an end part of the second molding core. The obviousness of such limitation has not been demonstrated over Budinski et al. in view of Shimizu et al. The Office Action's rejection seems to rely on Figure 3 of Shimizu et al. for this limitation and the Office Action attempts to modify Budinski et al. to include such limitation. However, there is no disclosure or suggestion in Budinski et al. in view of Shimizu et al. to have the lower die of Budinski et al. be, for example, wider than the upper die so as to have the structure found in Figure 3 of Shimizu et al. No advantage to avoid the inclination of a lens surface by making the lower die surface extend beyond the

upper die surface has been disclosed by Shimizu et al., as stated on the second full paragraph of page 3 of the Declaration. Accordingly, there is no teaching in Budinski et al. in view of Shimizu et al. to have the structure of Figure 3 in Shimizu et al. be incorporated in the invention of Budinski et al. such as, for example, to have the lower die be wider than the upper die. Accordingly, the cited art fails to disclose or suggest all of the limitations of claims 5 and 6.

The present argument regarding claims 5 and 6 also applies to claims 7 and 13.

Furthermore, Fig. 5 of Budinski et al. shows the molds with an induction heating coil 116 around them. If the sliding core parts 3L' and 3R' as well as the cylinder 4, which is necessary to move sliding core parts 3L' and 3R', were added to the invention of Budinski et al., this would interfere with the positioning of the heating coils. Furthermore, Budinski et al. discloses in column 4, lines 55-57 that "upper and lower mold halves 102, 104 preferably reside in a mold body." The addition of the sliding core parts 3L' and 3R' as well as cylinder 4 would prohibit the addition of a mold body that has the mold halves within it since the sliding core parts 3L' and 3R' and the cylinder 4 require much space. The attached Declaration, in the section titled Heating states, *inter alia*, that adding the sliding core parts 3L and 3R' as well as cylinder 4 to the invention of Budinski et al. would significantly interfere with the heating of the mold apparatus of Budinski et al. Accordingly, Budinski et al. teaches away from the modification of Budinski

et al. in view of Shimizu et al. The Federal Circuit has stated that, generally, a reference that teaches away cannot serve to create a *prima facie* case of obviousness. *See In re Gurley*, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

Accordingly, in light of the aforementioned reasons, *prima facie* obviousness of claims 5 and 6 is absent.

Regarding claims 12 and 18-20, the Examiner's position seems to be that the combination of Budinski et al. and Shimizu et al. would result in a situation where the glass is restricted. However, there is no indication that the amount of glass material utilized in Budinski et al. is sufficient to reach a restriction placed at the peripheral portion of the mold surfaces. Accordingly, the glass is therefore not being restricted to homogenize the optical performance of lens elements, as recited in claims 12 and 18-20, since there is no indication that the glass material is being restricted.

Moreover, in the Amount of Glass Molding Material Used section of the Declaration, it is explained that in column 6, lines 42-67 of Budinski et al. it is disclosed that the if the glass flows too quickly that the resulting lenses will be of diminished quality. The Declaration explains that Budinski et al. teaches that the volume of the glass preform cannot be too big since this will increase the velocity of the material and reduce the quality of the lenses. Accordingly, Budinski et al. teaches against having excessive amounts of glass material and therefore teaches away from having so much glass material that it would reach a restriction placed

on a peripheral portion of the mold surfaces. Thus, no showing exists that the glass in Budinski et al. in view of Shimizu et al. is being restricted to homogenize the optical performance of lens elements, as recited in claims 12 and 18-20.

Additionally, claims 12 and 18-20 recite that the glass is restricted to homogenize the optical performance of lens elements in a central part and a peripheral part of the lens preform. In contrast, Shimizu et al. teaches the opposite. As disclosed in the Shape of Lenses section of the Declaration, the placement of the slide core portions of Shimizu et al. adversely affects the optical performance because circular space portion 5A and concave portion space 5B will create additional shapes which adversely affect the optical performance of a periphery of a lens. The Declaration further states that the placement of the slide core portions of Shimizu et al. in Budinski et al. in a situation where there is enough glass material such that the additional shapes are created will change the optical performance adversely in the peripheral regions of the glass material relative to other portions of the glass material. Accordingly, Budinski et al. in view of Shimizu et al. does not disclose restricting the flow of the lens preform so as to homogenize the optical performance of lens elements disposed in a central area and lens elements disposed in a peripheral area of the lens preform, as recited in claims 12 and 18-20. Rather, Budinski et al. in view of Shimizu et al. is doing the opposite when the additional shapes are created.

Also, as explained in the Shape of Lenses section of the attached Declaration, the invention of Shimizu et al. is configured such that overflow material flows into circular space portion 5A or concave portion space 5B and creates a pressure differential between the central glass material and the peripheral glass material. The Declaration states that if excess glass material is utilized in Budinski et al. that this would create a pressure differential in Budinski et al. between the center and periphery of the lens material leading to a difference in the transfer performance. This situation will then lead to a difference in optical performance. Thus, there is no disclosure in Budinski et al. in view of Shimizu et al. that the glass material is restricted to homogenize the optical performance of lenses in a central portion and a peripheral portion of the lens preform, as recited in claims 12 and 18-20.

Accordingly, for the aforementioned reasons, it is Applicant's position that claims 12 and 18-20 are patentable over Budinski et al. in view of Shimizu et al.

Claims 8 and 14 have been rejected under 35 U.S.C. § 103(a) as obvious over Budinski et al. in view of Shimizu et al. and further in view of U.S. Patent No. 5,817,161 (Tagaki et al.).

Claims 8 and 14 recite that the first molding core has an end part with a radius smaller than the outermost radial dimension of the first molding core. The Office Action states that Budinski et al. and Shimizu et al. fail to disclose this limitation and relies on Tagaki et al. for this teaching with the reasoning that a

flange section like the one disclosed in Tagaki et al. would help limit the thickness of the molded glass.

The Supreme Court has made clear that a claim composed of several elements "is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art" and stated the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *See KSR International Co. v. Teleflex Inc. et al.* 82 USPQ2d 1385, 1396 (2007). In column 4, lines 47-48 of Budinski et al. is disclosed that compression is performed to a positive stop. Thus, since a positive stop is present, there is no need to modify Budinski et al. as shown in Tagaki et al. since a flange to stop the compression is unnecessary since a positive stop is present. Accordingly, one of ordinary skill in the art would not be prompted to combine Budinski et al. in view of Shimizu et al. with Takagi et al. Accordingly, claims 8 and 14 are believed patentable over the cited art.

Claims 9, 11, 15, and 17 have been rejected under 35 U.S.C. § 103(a) as obvious over Budinski et al. in view of Shimizu et al. and further in view of JP 03-146427 (Ikeuchi et al.).

Claims 9 and 15 have been cancelled, making their rejection moot.

Regarding claims 11 and 17, no reason has been provided to modify Budinski et al. to have at least a part of the restrictor between the first molding

core and second molding core. The Supreme Court has made clear that demonstrating that elements are known in the art is insufficient to establish obviousness and explained the importance of identifying a reason to combine the elements in the way the claimed new invention does. *See KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (U.S. 2007).

Also, if the objective of combining Budinski et al. and Shimizu et al. is to keep the dies laterally constrained, then there would be no reason to put the sliding core parts at least in part between the molding cores since the molding cores are supposed to be laterally constrained.

Accordingly, *prima facie* obviousness of claims 11 and 17 is absent.

Claims 10 and 16 have been rejected under 35 U.S.C. § 103(a) as obvious over Budinski et al. in view of Shimizu et al. and further in view of U.S. Patent No. 6,813,906 (Hirota et al.).

Claims 10 and 16 have been cancelled, making their rejection moot.

Applicant respectfully requests a one month extension of time for responding to the Office Action. **The fee of $120.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.**

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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Declaration Under 37 C.F.R. § 1.132
English translation of Shimizu et al.